NICHOLAS H. PATTON (SB 15631000)
Patton, Tidwell & Schroeder, L.L.P.
4605 Texas Blvd., P.O. Box 5398
Texarkana, Texas 75505-5398
Telephone: 903/792-7080
Facsimile: 903/792-8233

WILLIAM C. ROOKLIDGE *(Pro Hac Vice)*
RUSSELL B. HILL *(Pro Hac Vice)*
TOM CRUNK *(Pro Hac Vice)*
Howrey Simon Arnold & White, LLP
2020 Main Street, Suite 1000
Irvine, California 92614-8200
Telephone: 949/721-6900
Facsimile: 949/721-6910

Attorneys for Plaintiffs
THE MASSACHUSETTS INSTITUTE OF TECHNOLOGY and
ELECTRONICS FOR IMAGING, INC.

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**UNITED STATES DISTRICT COURT**
**EASTERN DISTRICT OF TEXAS**
**TEXARKANA DIVISION**

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| THE MASSACHUSETTS INSTITUTE OF TECHNOLOGY, a Massachusetts corporation, et al.<br><br>Plaintiffs,<br><br>v.<br><br>ABACUS SOFTWARE INC., a Michigan corporation, et al.<br><br>Defendants. | Case No. 5:01:CV344<br><br>Hon. David Folsom<br>U.S. District Judge<br><br>Hon. Caroline M. Craven<br>U.S. Magistrate Judge |

**PLAINTIFF'S SUR-REPLY REGARDING COREL'S CROSS-MOTION FOR SUMMARY JUDGEMENT OF NON-INFRINGEMENT**

The Court should strike Corel's improper Reply brief and otherwise deny Corel's Cross-Motion For Summary Judgment of Non-Infringement. In a blatant effort to sandbag Plaintiffs, Corel never addressed prosecution history estoppel in its Cross-Motion. Now, in its Reply brief, Corel raises this completely new legal and factual issue and submits extensive materials in violation of Local Rule CV 7(a)(1). Because Corel's Reply violates the Local Rules, the Court should strike it.

Even if the Court does not strike Corel's Reply, Corel's Cross-Motion fails as a matter of law. Corel does not address or meet its burden for establishing the applicability of prosecution history estoppel. In short, including the word "interactively" in Claim 1 did not narrow its scope; prosecution history estoppel therefore cannot apply. Thus, Plaintiffs are entitled to a range of equivalents reaching Corel's products.

Corel also adds to its Reply a section re-hashing the fully briefed marking issues. Corel once again fails to present any case law showing that the marking statute applies to products that do not literally infringe the subject patent. In addition, Corel, like all other Defendants on this issue, fails to identify a single unmarked patented system—even one that might infringe under the Doctrine of Equivalents.

**1. The Court Should Strike Corel's Improper Reply Brief.**

This Court limits reply briefs, including attachments, to 10 pages. Local Court Rules CV 7(a)(1). Corel's Reply, including attachments, contains 35 pages—well over three times the limit. Local Rule 7-(a)(1) is designed to prevent exactly what Corel has attempted to do here: sandbagging the non-moving party by introducing new material withheld from the original motion. The Court should not permit Corel to succeed and should therefore strike Corel's improper Reply. At a minimum, the Court should strike the excess pages.

**2. Corel Fails To Show That The Addition Of "Interactively" Narrowed Claim 1.**

Even if the Court does not strike Corel's Reply, Corel's new prosecution history estoppel argument fails as a matter of law. Corel bases its argument solely adding the word "interactively" in an amendment to Claim 1. Corel, however, does not and cannot meet its burden of showing that the addition of "interactively" narrowed the scope of Claim 1. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1366 (Fed. Cir. 2003) (accused infringer must establish that the amendment narrowed the claim before proceeding with prosecution history estoppel inquiry). Indeed, Corel fails to even acknowledge its burden here. Instead, Corel proclaims that Plaintiffs "admit" that the word "interactively" "incorporates" knob computers. Plaintiffs admit nothing of the sort; Plaintiffs merely apply the Court's claim construction. Corel misses the point: the Court construed aesthetic correction circuitry to include knob computers and their equivalents under 35 U.S.C. Section 112(6). Corel, however, never shows what the scope of the original Claim 1 was under Section 112(6). Nor does Corel even attempt to compare the original Claim 1 with the amended Claim 1 to show that the amendment narrowed Claim 1. Corel therefore fails to show that adding the word "interactively" in any way narrowed Claim 1. Accordingly, Corel cannot avail itself of prosecution history estoppel. *See Festo*, 344 F.3d at 1366 ("If the amendment was not narrowing, then prosecution history estoppel does not apply.").

Moreover, even if Corel tried to meet its burden of showing how "interactively" narrowed Claim 1, it could not succeed. As originally submitted, the relevant portion of Claim 1 read: "aesthetic correction circuitry for introducing aesthetically desired alteration into said appearance signals to produce modified appearance signals." Declaration of Tom Crunk ("Crunk Decl."), Ex. A (Supplemental Amendment dated March 26, 1984) at 1. This language was amended to read: "aesthetic correction circuitry for interactively introducing aesthetically desired alterations into said appearance signals to produce modified appearance signals." *Id.* (relevant amendment underlined, other amendments not noted). This amendment could not have narrowed the aesthetic correction circuitry limitation for at least three reasons. First, interactivity is inherent in the aesthetic correction circuitry, otherwise the system of Claim 1 simply will not work. If the operator can not specify changes to the appearance signals and see those changes reflected in the image on the monitor, then there is no point in further converting the displayed image appearance signals into colorant selection signals to replicate the displayed image. As Dr. Schreiber makes clear, ink selection can only be made after the image has been altered to the satisfaction of the user. *Id.* at 8. This alteration is inherently interactive because it requires the user to make and view changes. A key feature of the system of Claim 1 is that it makes the printed image look like the displayed image. MIT Patent at 3:59-63 (describing how operator needs no knowledge of ink or paper characteristics because system makes the printed image look like the edited displayed image). Thus, adding "interactively" to "aesthetic correction circuitry" in Claim 1 simply made explicit an inherent characteristic of the aesthetic correction circuitry. Therefore, it could not have narrowed Claim 1. *See Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359 (Fed. Cir. 2001), *cert denied*, 537 U.S. 880 (2002), (claim limitation not narrowed for purposes of prosecution history estoppel where amendment only added language reflecting inherent characteristic of limitation).

Second, the Court construed "aesthetic correction circuitry" as a means-plus-function limitation under 35 U.S.C. Section 112(6). Order On U.S. Magistrate Judge's Report And Recommendation Regarding Claim Construction "Order Regarding Claim Construction." Therefore, the Court limited "aesthetic correction circuitry" to the structure disclosed in the specification and equivalents thereof. 35 U.S.C. §112(6). The original specification disclosed knobs and knob computers as the structure for performing the function of the aesthetic correction circuitry. Thus, under the Court's construction, "aesthetic correction circuitry" was already limited to circuitry with knob computers before the addition of "interactively." Accordingly, adding "interactively" could not have narrowed the limitation.

Third, if "interactively" refers to anything specific in Claim 1, it is the display means. At the same time that "interactively" was added to Claim 1, the phrase "display means connected to the scanner for receiving the appearance signals" also was added. Crunk Decl., Ex. A at 1.[1] This amendment further clarified that the display means is used to first obtain a satisfactory image before the ink selection mechanism makes the printed image look like the displayed image. *Id.* at 5, 8. Without the display means, one cannot interactively introduce aesthetically desired alterations into the appearance signals. Thus, rather than narrowing the mechanisms used by the human operators to communicate with the computer(s) of Claim 1, "interactively" simply makes explicit that an image is displayed on a device and altered as desired by the user before replication by the ink selection mechanism.

In sum, Corel does not and cannot show how Claim 1 was narrowed through the addition of the word "interactively." Without this initial showing the Court cannot apply prosecution history estoppel to Claim 1 and thereby bar any range of equivalents. Corel's accused products therefore are susceptible to infringement of Claim 1 under the Doctrine of Equivalents.

**4. Corel's Attack On Mr. McIlroy's Declaration Fails To Remove Genuine Issues Of Material Fact.**

Corel argues without proper support that Mr. McIlroy's declaration deals with the wrong time frame and fails to address the relevant test. The only authority cited by Corel is *Festo*, which is inapposite because *Festo* deals only with rebutting the presumption of complete

[1] Corel neither contends that the addition of "display means" narrows Claim 1 nor seeks prosecution history estoppel on the basis of this addition.

surrender of equivalents due to a narrowing amendment. Moreover, the correct time period for determining equivalency "is at the time of infringement," not some earlier time. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 37 (1997). Mr. McIlroy's declaration accordingly creates a genuine issue of material fact requiring denial of Corel's motion; namely, whether graphical user interfaces with sliders are the equivalent of knob computers under the Court's current claim construction.

**5. The Court Should Reject Corel's Re-Hashed Marking Statute Arguments.**

Finally, not content with the full briefing on the marking issue, Corel attempts yet another bite at the marking argument in its Reply. Corel, however, still fails to provide a single case holding that a patented article is one that infringes under the Doctrine of Equivalents. Even if there were such authority, Corel still fails to identify a complete unmarked system sold by Plaintiffs or their licensees that would infringe Claim 1 even under the Doctrine of Equivalents. The Court should therefore reject Corel's marking arguments.

DATED: February 18, 2004

Respectfully,

By: Nicholas H. Patton w/ permission by RW Schroeder

NICHOLAS H. PATTON (SB 15631000)
Patton, Tidwell & Schroeder, L.L.P.
4605 Texas Blvd., P.O. Box 5398
Texarkana, Texas 75505-5398
Telephone: 903/792-7080
Facsimile: 903/792-8233

WILLIAM C. ROOKLIDGE
RUSSELL B. HILL
TOM CRUNK
Howrey Simon Arnold & White, LLP
2020 Main Street, Suite 1000
Irvine, California 92614-8200
Telephone: 949/721-6900
Facsimile: 949/721-6910

## CERTIFICATE OF SERVICE

I, Nicholas H. Patton, hereby certify that a copy of the foregoing was served on counsel of record for Corel by first class mail and fax on February 18, 2004.

Nicholas H. Patton / RWS

NICHOLAS H. PATTON

**UNITED STATES DISTRICT COURT**
**EASTERN DISTRICT OF TEXAS**
**TEXARKANA DIVISION**

THE MASSACHUSETTS INSTITUTE OF TECHNOLOGY, a Massachusetts corporation, et al.

Plaintiffs,

v.

ABACUS SOFTWARE INC., a Michigan corporation, et al.

Defendants.

Case No. 5:01:CV344

**DECLARATION OF TOM CRUNK IN SUPPORT OF PLAINTIFFS' SUR-REPLY REGARDING COREL CORP. AND COREL INC.'S CROSS-MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT**

Hon. David Folsom
U.S. District Judge

Hon. Caroline M. Craven
U.S. Magistrate Judge

I, Tom Crunk, declare as follows:

1. I am an attorney at the law firm of Howrey Simon Arnold & White, LLP, counsel for Plaintiffs The Massachusetts Institute of Technology and Electronics For Imaging, Inc. in this action. I am admitted pro hac vice in this matter. I am a member in good standing of the State Bar of California. Unless otherwise stated, I have personal knowledge of the facts set forth in this Declaration and, if called as a witness, could and would testify competently to such facts under oath.

2. Attached as **Exhibit A** is a true and correct copy of the relevant pages of the March 26, 1984 Supplemental Amendment And Disclosure Statement from the prosecution history of U.S. Patent No. 4,500,919.

Executed February 18, 2004, at Irvine, California.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

TOM CRUNK

MAIL ROOM MAR 28 1984 PAT. & TRADE MARK OFF.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: William Schreiber Group Art Unit: 231

Serial No.: 374,804 Examiner: Masinick

Filed: May 4, 1982

For: Color Reproduction System

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

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SUPPLEMENTAL AMENDMENT
AND DISCLOSURE STATEMENT

Sir:

In the Claims

Please amend the claims as follows:

Claim 1. (Amended) A system for reproducing a color original in a medium using a selected multiplicity of reproduction colorants, the system comprising in serial order:

a. a scanner for producing from said color original [a train of] a set of three tristimulus appearance signals dependent on [at least three color values] the colors in said original;

b. display means connected to the scanner for receiving the appearance signals and aesthetic correction circuitry for interactively introducing aesthetically desired alterations into said appearance signals to produce modified appearance signals; and

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EXHIBIT A

the use of applicant's system is disclosed in connection with a rotogravure system employing 3 colored inks and a black ink; the preferred system further includes circuitry to optimize the amount of black ink thereby minimizing the use of expensive colored inks.

Applicant wishes to stress one important distinction between his invention and the applied reference (Pugsley): in the applicant's invention, a display means (i.e., a T.V. monitor) is used as an integral part of the aesthetic correction system. Once a satisfactory picture is obtained by the user on the T.V., applicant's colorant selection mechanism makes the reproduction (the inked page) look like the T.V. In contrast, in Pugsley's scheme, the T.V. is employed at the end of the process to yield a general prediction of the ink selection results. In other words, applicant makes the color reproduction look like the T.V., while the reference makes the T.V. look like the page.

The language of claim 1 has been amended to clarify the differences in operational sequences between applicant's system and that of the reference. Specifically, the words "in serial order" and the recitation of how the elements are connected stresses the different operations. Moreover, the term "a display means" is now positively recited as part of applicant's aesthetic correction means. Claims 4 and 10 have also been amended to clarify the applicant's contribution to the art. New claim 22 describes applicant's editing method. Support for

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different principles. In applicant's system, appearance signals are modified directly by the user in an interactive fashion and only when they are satisfactory are the proper inks selected.

Additionally, Pugsley does not disclose or employ a color balance means for altering the appearance signals which precisely corrects for exposure errors (as recited in applicant's claim 6) or a translation means for converting tristimulus values into luminance-chrominance values (as recited in applicant's claim 10). Likewise, Pugsley does not discuss or suggest any method for undercolor removal or provide even an enabling disclosure for finding the values to be placed in the look-up table, generally, much less a technique for creating a four-color look-up table that minimizes expensive ink usage (as recited in claim 19).

For these reasons, it is believed that Pugsley does not anticipate applicant's claims 1-4, 6, 10 or 19. Moreover, it is submitted that Pugsley does not render obvious any of the other dependent claims (or independent claims 20 and 22). Specifically, Pugsley does not disclose or suggest an excess gamut alarm (applicant's claim 5), tone scale memories (claims 7, 8 and 9), a high speed video data path in combination with a low speed knob computer for aesthetic correction (claim 13) or undercolor removal (claim 15). Likewise, Pugsley neither discloses nor suggests the method of calculating a desired